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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,856	04/21/1999	TODD R. COLLART	IA 1506.01A US	7668

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DISCOVISION ASSOCIATES
INTELLECTUAL PROPERTY DEVELOPMENT
2355 MAIN STREET, SUITE 200
IRVINE, CA 92614

EXAMINER

RODRIGUEZ, PAUL L

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/295,856

Applicant(s)

COLLART, TODD R.

Examiner

Paul L. Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21, 47, 50-53, 56, 58, 62, 65, 68-70 and 74-81 is/are pending in the application.
4a) Of the above claim(s) 21 and 79-81 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 47, 50-53, 56, 58, 62, 65, 68-70 and 74-78 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The amendment filed 3/3/05 has been received and considered. Claims 21, 47, 50-53, 56, 58, 62, 65, 68-70 and 74-81 are presented for examination. Claims 21 and 79-81 have been withdrawn from consideration.

Claim Objections

2. Claims 51 and 77 are objected to because of the following informalities:

Claim 51 lines 2-3 recite, "said identifier on said optical storage medium is performed by a content provider", it is unclear how an "identifier" is performed.

Claim 77 line 3 recites "the identifier information stored on the BCA" there is no previous reference to storing on the BCA.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 74-78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 74 recites the limitation "the information" in line 2. There is insufficient antecedent basis for this limitation in the claim. Previously "user information", "new information" and "support information".

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6. Claim 76 recites the limitation "the identifier information" in line 2. There is insufficient antecedent basis for this limitation in the claim. Previously the claim recites "an identifier", "user information", "new information" and "support information" but no identifier information.

7. Claim 77 recites the limitation " the identifier information " in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 47,50-53,56, 58, 62, 65, 68-70, 74 and 75 are rejected under 35 U.S.C. 102(e) as being anticipated by Uranaka et al (U.S. Pat 6,470,085). The claimed invention reads on Uranaka et al as follows, (like or similar limitations have been grouped together):

Uranaka et al discloses (claim 47) a method for providing selective access to data on an optical storage medium (abstract, col. 1 lines 9-15, col. 4 lines 46-65), (claim 47, 59) receiving an identifier (reference number 30, col. 5 lines 58-62) on a burst cut area (BCA) (figure 2, 4) on said optical storage medium (reference numbers 21, 22, 24, figure 2, col. 5 lines 25-31, col. 5 line 58 – col. 6 line 13, col. 8 lines 45-62), (claim 47) receiving pertinent user information (PK_u, reference number 32, reference number 35, col. 6 line 66 – col. 7 line 9, col. 7 lines 58-67, col. 8 lines 45-62), (claim 47), verifying said identifier and said pertinent user information at a database

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(col. 7 line 54 – col. 8 line 41, col. 8 line 62 – col. 9 line 13), performing a first table lookup to determine a title, a genre of said medium, a retailer, a broadcast update, or a pre-defined condition, the pre-defined condition being new information, support information (as written only one required to meet the limitation, col. 7 line 58 – col. 8 line 17, col. 8 line 59 – col. 9 line 29 for predetermined condition), performing a second table lookup (col. 9 lines 30-36) to determine a redirect transaction to said retailer, an advertising, a banner, a specific video that can be played, multimedia element, or whether medium can be unlocked or installed (col. 9 line 36 – col. 10 line 21, The server performs a look up of table 70 to determine an allowable duration, Examiner considers this to read on unlocked), (claim 47) tailoring a response based on a pre-defined condition (col. 8 line 42 – col. 16 line 46, figures 5-20, based on the terms of use, access is either provided or not), and (claim 62), passing the response to a remote location (response from server to client, where client is remote from server), (claim 50, 63, 71) wherein the response is an authorization for an access to data stored on said optical data storage (reference numbers 650, 700, 800 of figures 5 with description), (claim 51) wherein said identifier on said optical storage medium is performed by a content provider (inherent, col. 1 lines 16-20, col. 5 lines 31-42), (claim 52) wherein said data comprises multimedia data (col. 4 lines 46-65, CD-ROM, DVD), (claim 74) wherein the information is updated and stored in a BCA database (reference number 60, figure 6a) (claim 75), broadcasting one of the information and the updated information (col. 7 lines 54-57, information sent to and from the server and client is considered broadcasting), (claim 53) a system for providing selective access to data on an optical storage medium (figure 1), comprising a first receiver for receiving an identifier on a burst cut area (BCA) on said optical storage medium (reference number 130, col. 6 lines 51-54, 58-63), a second receiver for receiving pertinent user information (reference number 120, col. 6 lines 50-51, 58-63), said

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pertinent user information and said identifier being verified at a database (col. 7 line 54 – col. 8 line 41) a determinator for performing a first table lookup to determine a title, a genre of said medium, a retailer, a broadcast update, or a pre-defined condition, the pre-defined condition being one of new information and support information (as written only one required to meet the limitation col. 8 line 59 – col. 9 line 29 for predetermined condition) and a second table lookup (col. 9 lines 30-36) to determine a redirect transaction to the retailer, an advertising, a banner, a specific video that can be played, multimedia element, or whether medium can be unlocked or installed (col. 8 line 45 – col. 10 line 21, The server performs a look up of table 70 to determine an allowable duration, Examiner considers this to read on unlocked), and a response generator (server) for tailoring a response to be sent to a remote location (client, col. 8 line 42 – col. 16 line 46), said response being based on the first and second table lookups (col. 8 line 42 – col. 16 line 46), (claim 56) wherein said receivers are located in one location (reference number 2), (claim 58, 70) wherein said data comprises multimedia data (col. 4 lines 46-65, inherent CD-ROM and DVD), (claim 65) a system for providing selective access to data on an optical storage medium (figure 1), comprising a receiver (reference number 130) for receiving pertinent user information (PK_u, reference number 32, col. 6 line 66 – col. 7 line 9) and an identifier (reference number 30) on a burst cut area (BCA) (reference number 23) in conjunction with said data (reference numbers 21, 22, 24, figure 2), a verifier to verify said identifier at a separate database (reference number 8) a determinator for performing a first table lookup and a second table look up (col. 8 line 45 – col. 10 line 21) and a response generator for tailoring a response to be sent to a remote location, said response being based on the first and second table lookups (col. 8 line 42 – col. 16 line 46), (claim 68) wherein said pertinent user information is provided by a content provider (inherent, col. 1 lines 16-20, col. 5 lines 31-42), (claim 69) wherein said response is an

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authorization for an access to data stored on said optical data storage (reference numbers 650, 700, 800). Examiner would like to point out that any reference to specific figures, columns and lines should not be considered limiting in any way, the entire reference is considered to provide disclosure relating to the claimed invention.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 76-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uranaka et al (U.S. Pat 6,470,085) in view of Brindze et al (U.S. Pat 5,822,291).

Uranaka et al teaches most all of the instant invention as applied to claim 71 above.

Uranaka et al fails to teach (claim 76) further comprising utilizing the identifier information to direct one of an e-commerce transaction and a "buy me" button to a retailer, (claim 77) further comprising providing a logic to control access to a web site, the logic being based on the identifier information stored on the BCA and (claim 78) wherein the logic redirects a consumer to a storefront of a retailer.

Brindze et al teaches (claim 76) further comprising utilizing the identifier information to direct one of an e-commerce transaction and a "buy me" button to a retailer (col. 8 lines 39 – col. 9 line 8, examiner considers "buy me" as anticipated by the "enhanced multimedia format" and purchasing) and (claim 78) wherein the logic redirects a consumer to a storefront of a retailer (col. 9 lines 1-5).

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Uranaka et al and Brindze et al are analogous art because they are both related to the distribution of multimedia on optical storage mediums.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the web and retailer access of Brindze et al in the system and method for providing selective access to data of Uranaka et al because Brindze et al teaches that their invention is directed to a multimedia transaction system that is particularly effective, versatile, inexpensive, and easy to use (col. 3 lines 20-22).

Response to Arguments

12. Applicant's arguments filed 3/3/05 have been fully considered but they are not persuasive.

Regarding the claim objections, deficiencies remain and have been introduced by the submitted amendment. See the deficiencies in the above objections and rejections under 35 U.S.C 112.

Regarding the rejection under Uranaka et al. Applicant argues that "Uranaka does not disclose performing a first table lookup to determine a title, a genre of said medium, a retailer, a broadcast update, or a pre-defined condition, the pre-defined condition being new information, support information and performing a second table lookup to determine a redirect transaction to said retailer, an advertising, a banner, a specific video that can be played, multimedia element or whether medium can be unlocked or installed." Examiner would like to point out that Uranaka et al does perform a first table look up, see col. 8 line 59 – col. 9 line 29 where a data table 60 is searched which contains various information including a limit value, duration, which are considered a pre-defined condition, support information. As written the claim only requires the first table lookup to determine one of the items. Uranaka et al also perform a second table look

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up, see col. 9 lines 30-39, where table 70 is searched for the duration information which is used to unlock access to the content. Again, as written the claim only requires the second table lookup to determine one of the items. Arguments not persuasive.

Regarding the rejection based on Uranaka et al in view of Oshima et al. The amendment removed the limitations in question and the rejection is moot.

Regarding the rejection based on Uranaka et al in view of Brindze. Applicant argues that the combination do not perform the first or second table lookups. As addressed above, Uranaka et al clearly discloses the two table lookups and the argument is without merit. The rejection is maintained.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yoshioka et al (U.S. Pub 2005/0071272) – Teaches a system and method that sells access to content provided on an optical storage medium.

Stefik et al (U.S. Pat 6,865,551) – teaches access to digital content with a look up procedure.

Cok (U.S. Pat 6,865,550) – teaches performing a look up to enable access to digital data.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**


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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul L. Rodriguez whose telephone number is (571) 272-3753. The examiner can normally be reached on 6:00 - 4:30 T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P. Picard can be reached on (571) 272-3749. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Paul L. Rodriguez
Primary Examiner
Art Unit 2125

PLR
6/2/05